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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
AGUSTIN, PETER VINCENT

ART UNIT	PAPER NUMBER
2627	

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/916,292	OHGAKE, MITSURU	
	Examiner	Art Unit	
	P. Agustin	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *8-11 and 17-20* is/are allowed.

6)☒ Claim(s) *1-7,12-16 and 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-21 are now pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 31, 2006 has been entered.

Claim Objections

3. Claims 1-3, 5, 7 & 21 are objected to because of the following informalities:

In regard to claim 1, the claimed step of "providing a recording and reading device..." should now be labeled as (a), and the subsequent steps should be labeled as (b), (c),...etc.

Claims 2, 3, 5, 7 & 21 also contain similar errors that need to be corrected.

Claim Rejections - 35 USC § 102 & 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-7, 12-16 & 21 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakajo (US 5,502,702).

In regard to claim 1, Nakajo discloses a method for optically recording information in a system (Figure 1) comprising the steps of: providing a recording and reading device (14, 16, 18, 22 & 26) that includes a first controller (e.g., the portion of element 26 that controls elements 16 & 18) and a strategy part (16 & 18) for conducting a strategy when optically recording information and an information processing apparatus (20 & 26) that includes a second controller (e.g., the portion of element 26 that controls element 20) and a strategy information storing part (20) storing the strategy information for operating said strategy part (16 & 18), wherein said providing step includes a step of providing said second controller separate from said first controller (although Figure 1 of Nakajo represents the recording control circuit 26 as one block, it is understood that this circuit includes several components which are provided "separately" from each other. For example, a first component inside element 26 controls elements 16 & 18, while a second component inside element 26 controls the ROM 20. These first and second components are interpreted by the examiner as corresponding to the claimed first controller and second controller, respectively); (a) reading said strategy information for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus with said second controller (column 5, lines 37-45); and (b) transmitting said strategy information read in said step (a) to said recording and reading device (column 5, lines 37-45).

In regard to claim 2, Nakajo discloses the steps of: (c) storing said strategy information, said strategy information corresponding to device information of said recording and reading

device and medium information of an optical recording medium, to said strategy information storing part (column 5, lines 30-34; see also column 1, lines 17-28, which teach that recording power differs depending upon the type of dyestuff on a disc, and write strategy needs to be adjusted accordingly); (d) transmitting the device information and the medium information from said recording and reading device to said information processing apparatus (column 5, lines 37-45); (e) reading said strategy information corresponding to said device information and medium information from said strategy information storing part in said information processing apparatus (column 5, lines 37-45); and (f) transmitting said strategy information with said medium information to said recording and reading device (column 5, lines 37-45).

In regard to claim 3, Nakajo discloses the steps of: (g) storing standard strategy information to said strategy information storing part (column 7, lines 26-35: "basic control information"); (h) reading said standard strategy information and transferring said standard strategy information to said recording and reading apparatus when the strategy information corresponding to the device information and the medium information transmitted from said recording and reading device is not stored in said strategy information storing part (column 7, lines 32-35).

In regard to claim 4, Nakajo discloses that said medium information is read and obtained from the optical recording medium (column 5, lines 35-45).

In regard to claim 5, Nakajo discloses that said step (h) cancels transmitting said device information and said medium information to said information processing apparatus when said medium information additionally provided to said strategy information stored in said strategy part corresponds to said medium information of said optical recording medium, and activates

said strategy part to record to the optical recording medium (understood from column 7, lines 26-35).

In regard to claim 6, Nakajo discloses that a plurality of data sets of the strategy information is stored in said strategy part (column 5, lines 43-45).

In regard to claim 7, Nakajo discloses that said step (b) is conducted just before starting recording information to said optical recording medium (column 5, lines 40-42).

In regard to claim 12, Nakajo discloses a computer-readable recording medium (Figure 1, element 10) recorded with program code for causing a computer (B & C) to optically record information in a system comprising a recording and reading device (14, 16, 18, 22 & 26) that includes a first controller (e.g., the portion of element 26 that controls elements 16 & 18) and a strategy part (16 & 18) for conducting a strategy when optically recording information and an information processing apparatus (20 & 26) that includes a second controller (e.g., the portion of element 26 that controls element 20) and a strategy information storing part (20) storing the strategy information for operating said strategy part, said first and second controllers being separately provided (although Figure 1 of Nakajo represents the recording control circuit 26 as one block, it is understood that this circuit includes several components which are provided "separately" from each other. For example, a first component inside element 26 controls elements 16 & 18, while a second component inside element 26 controls the ROM 20. These first and second components are interpreted by the examiner as corresponding to the claimed first controller and second controller, respectively), and said program comprising the codes for: (a) reading said strategy information for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus with

said second controller (column 5, lines 37-45); and (b) transmitting said strategy information read by said code (a) to said recording and reading device (column 5, lines 37-45).

Claims 13-16 have limitations similar to those of claims 2-5; thus, they are rejected on the same basis.

In regard to claim 21, Nakajo discloses a method for optically recording information in a system (Figure 1) comprising: providing (1) a recording and reading device (14, 16, 18, 22 & 26) that includes a first controller (e.g., the portion of element 26 that controls elements 16 & 18) and a strategy part (16 & 18) for storing and conducting a strategy when optically recording information and (2) an information processing apparatus (20 & 26) that includes a second controller (e.g., the portion of element 26 that controls element 20) and a strategy information storing part (20) storing the strategy information for operating said strategy part (16 & 18), wherein said providing step includes a step of providing said second controller separate from said first controller (although Figure 1 of Nakajo represents the recording control circuit 26 as one block, it is understood that this circuit includes several components which are provided "separately" from each other. For example, a first component inside element 26 controls elements 16 & 18, while a second component inside element 26 controls the ROM 20. These first and second components are interpreted by the examiner as corresponding to the claimed first controller and second controller, respectively); (a) reading said strategy information for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus with said second controller (column 5, lines 37-45); and (b) transmitting said strategy information read in said step (a) to said recording and reading device and storing said strategy information in said strategy part (column 5, lines 37-45).

Alternatively, in regard to claims 1, 12 & 21, Nakajo does not explicitly disclose a first controller separately provided from a second controller (this is assuming that Figure 1, element 26 in its entirety is read to correspond to both the first controller and the second controller). However, absent any evidence of criticality, separately providing the claimed first and second controllers would have been an obvious matter of engineering choice in a case where it is desirable to access each controller individually. See *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) and MPEP § 2144.04 (Making Separable). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention by the Applicant to have separately provided the first and second controllers of Nakajo, the motivation being to enable individual access to each controller.

Allowable Subject Matter

7. Claims 8-11 & 17-20 are allowed over the prior art of record.

Response to Arguments

8. In response to Applicant's amendments to claims 2 & 13, the objection to the specification and the claims, and the rejection of claims 2-5 & 13-16 under 35 U.S.C. § 112-1st paragraph have been withdrawn, rendering the arguments on page 13, paragraphs 3-5 moot.

9. Applicant's arguments filed August 31, 2006 have been fully considered but they are not persuasive.

(a) In response to Applicant's arguments on page 14, first thru last paragraphs that Nakajo does not disclose providing a second controller separate from said controller, the examiner disagrees. In light of this newly added feature, the claimed "first controller" is now read to correspond to the portion of element 26 that controls elements 16 & 18,

while the claimed "second controller" is now read to correspond to the portion of element 26 that controls element 20. Note that although Figure 1 of Nakajo represents the recording control circuit 26 as one block, it is understood that this circuit includes several components which are provided "separately" from each other. For example, a first component inside element 26 controls elements 16 & 18, while a second component inside element 26 controls the ROM 20. These first and second components are interpreted by the examiner as corresponding to the claimed first controller and second controller, respectively. See the rejection under 35 U.S.C. § 102(b) above.

(b) Furthermore, assuming *arguendo* that Nakajo does not disclose a first controller separately provided from a second controller, the claims are alternatively rejected under 35 U.S.C. § 103(a), as noted above. Absent any evidence of criticality, separately providing the claimed first and second controllers would have been an obvious matter of engineering choice in a case where it is desirable to access each controller individually. See *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) and MPEP § 2144.04 (Making Separable).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Agustin whose telephone number is 571-272-7567. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. L. Wellington can be reached on 571-272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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